Applicant requests favorable reconsideration and withdrawal of the rejection set forth in

the above-identified Office Action in view of the following remarks.

Claims 1-11 remain pending, with claims 1 and 9-11 being independent. The claims have

not been amended herein.

Claims 1-11 are rejected in the Office Action under 35 U.S.C. § 103(a) as being

unpatentable over Motoyama (U.S. Patent Application Pub. No. 2002/0030836) in view of Ett

(U.S. Patent No. 5,227,893).

Applicant respectfully traverses the rejection, and submits that the claimed invention is

patentably distinguishable from the cited references for at least the following reasons.

In general, the claimed invention allows for designation of an output method based on a

particular type of data. Other art, such as Motoyama, may provide for a user to select amongst

different output methods. Art such as Motoyama, however, does not provide the combination of

claimed features that allow for the automatic selection of certain data based on a designated

output method.

Specifically considering the claims, independent claim 1 recites an image processing

apparatus that comprises, inter alia, a first input means for inputting first data created by

predetermined application software, as well as second input means for inputting second data

converted into image data of a predetermined format on the basis of the first data.

Applicant submits that Motoyama does not disclose or suggest such a combination of

first and second means. Motoyama appears to disclose input of first data such as an image.

Motoyama also appears to disclose input of second data, such as an overlay image reading

"Confidential Don't Make Copy." Figure 10, paragraph 0051. While Motoyama discloses that
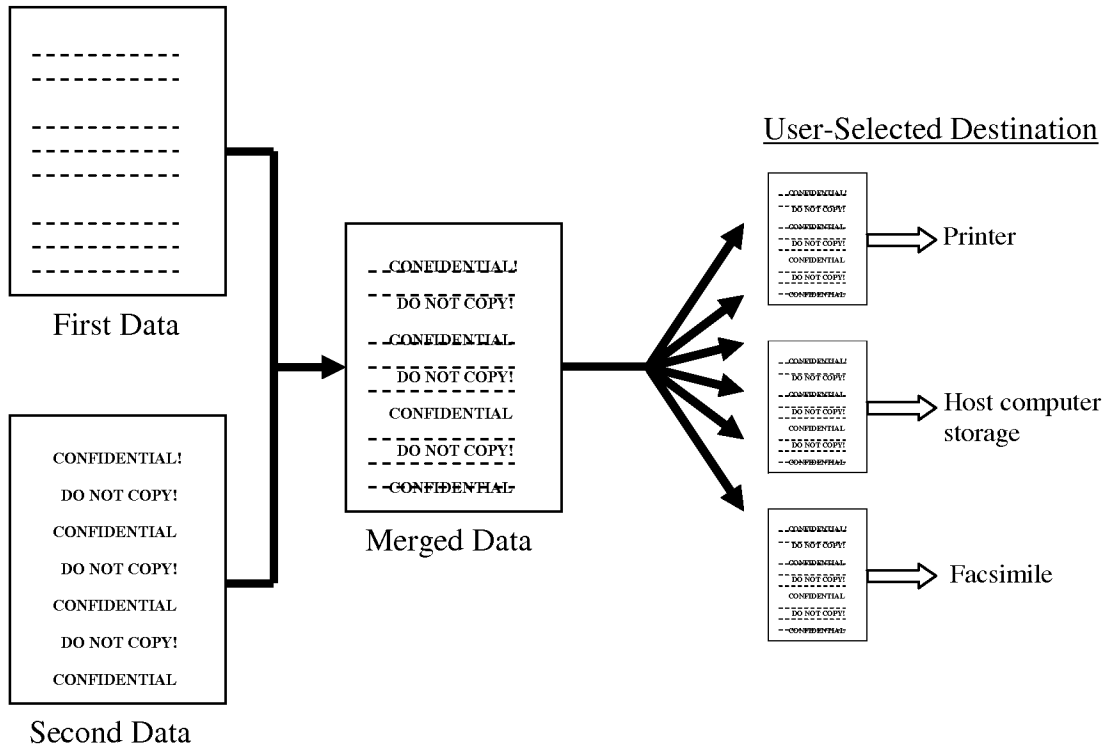
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the second data is <u>merged</u> with the first data (see, e.g., paragraph [0034], but there is no disclosure of the second data being <u>converted into image data</u> on the basis of the first input data. Indeed, the "Confidential" overlay image in <u>Motoyama</u> is already in image format when available for selection by a user, not disclosed as converted into image format. See, e.g, paragraph [0051]. Thus, even if the overlay image in <u>Motoyama</u> is equated to "second data," this data is not "converted into image data format on the basis of the first data," as recited in independent claim 1.

Independent claim 1 further recites a control means for selecting either the input first or second data. Specifically, the claim recites that the control means automatically selects the first data, but does not select the second data, in response to a designation by a designation means of a transmission as the output method, and automatically selects the second data, but does not select the first data, in response to a designation by the designation means of a printing as the output method.
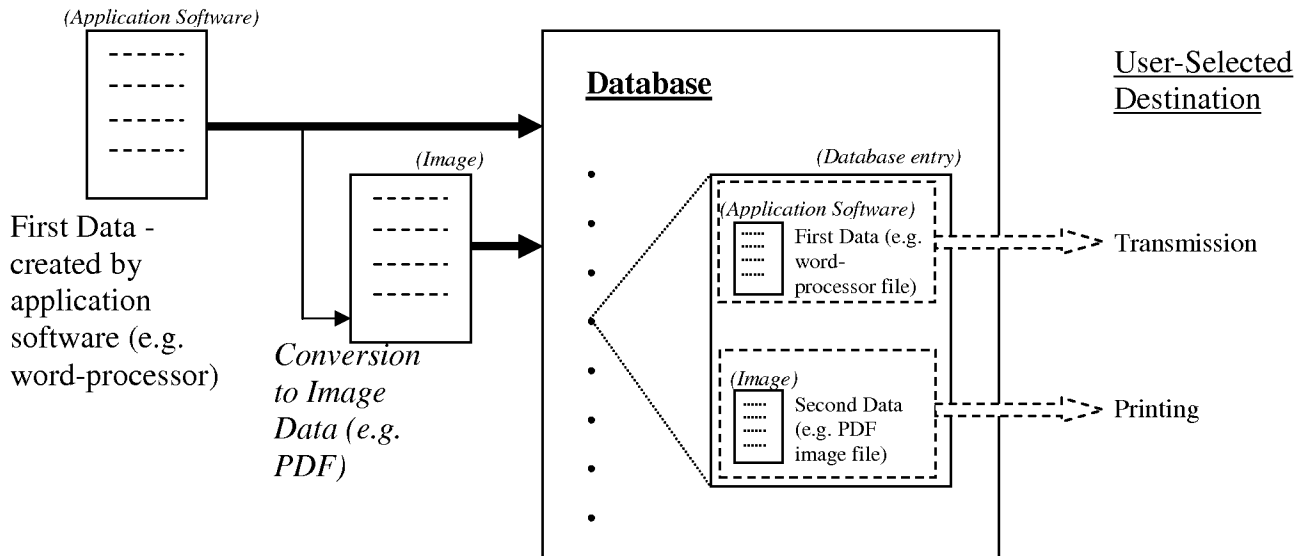
Applicant submits that <u>Motoyama</u> does not disclose a control means as recited in independent claim 1. In <u>Motoyama</u>, a user may select an output method for the merged data. See, e.g., paragraph 0035. For example, the merged data can be sent to a printer, a copier, or a facsimile machine. Figure 2. As discussed above, however, the "first and second data" in <u>Motoyama</u> are merged into one image document. As such, <u>Motoyama</u> cannot be understood to disclose or suggest a control means that selects the first or second data, individually, based on the designated output by a designation means. Simply put, the merging of data in <u>Motoyama</u> precludes the first data individually, but not the second data, to be designated for a specific output method, or vice versa.

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In order to aid in understanding the above-described distinctions between the claimed invention and <u>Motoyama</u>, Applicant is providing the diagram below. As discussed above, the depiction of the configuration of <u>Motoyama</u> shows the first and second data being separately input and then merged. The user may then select a particular destination for the <u>merged</u> data, e.g., a printer, a host computer storage, or a facsimile machine. On other hand, as generally shown in the illustration, the second input data of the claimed invention is the result of a conversion of the first data. The first and second input data are stored separately. As such, the claimed control means allows for the first data, but not the second data, to be output by a transmission. Further, the second data, but not the first data, may be output by printing.

Motoyama

First Data

Second Data

CONFIDENTIAL!
DO NOT COPY!
CONFIDENTIAL
DO NOT COPY!
CONFIDENTIAL
DO NOT COPY!
CONFIDENTIAL

Merged Data

CONFIDENTIAL!
DO NOT COPY!
CONFIDENTIAL
DO NOT COPY!
CONFIDENTIAL
DO NOT COPY!
CONFIDENTIAL

User-Selected Destination

Printer

Host computer storage

Facsimile

Applicant's Invention

(Application Software)

First Data -
created by
application
software (e.g.
word-processor)

*Conversion
to Image
Data (e.g.
PDF)*

(Image)

Database

(Database entry)

(Application Software)
First Data (e.g.
word-
processor file)

(Image)
Second Data
(e.g. PDF
image file)

User-Selected
Destination

Transmission

Printing

Applicant further submits that the secondary citation to Ett fails to cure the deficiencies in Motoyama. Ett is cited in the Office Action as disclosing index input means for inputting a specific index. Nevertheless, Applicant submits that Ett fails to disclose or suggest the features of independent claim 1 that Motoyama does not disclose or suggest, as discussed above.

Independent claims 9-11 recite a method and computer programs that include a step of inputting first data, a step of inputting second data converted into image data on the basis of the first data, and an output step of selecting either the first data or second data on the basis of a designated output method, which are analogous to the input means and control means recited in independent claim 1. Thus, Applicant submits that independent claims 9-11 are distinguishable from Motoyama and Ett for the reasons discussed above with respect to independent claim 1.

For at least the foregoing reasons, Applicant submits that the invention recited in independent claims 1 and 9-11 is patentably distinguishable from Motoyama and Ett

The dependent claims should also be deemed allowable, in their own right, for defining other patentable features of the present invention in addition to those recited in the independent claims. Applicant requests further individual consideration of these dependent claims.

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. Favorable consideration and early passage to issue of the application are earnestly solicited.

Any fee required in connection with this paper should be charged to Deposit Account No. 06-1205.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

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